

REMARKS

At the outset, the Applicant notes that the Examiner, in relation to the issue of joint inventorship, advised the Applicant of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a). (Office Action, at p. 4.) In response, the Applicant points out that he is the sole inventor. As such, issues relating to joint inventorship does not apply to the present invention.

Claims 1-25 stand rejected. The Applicant has cancelled claims 11, 20 and 24. Claims 1-3, 7, 8, 10, 12-14, 16, 17, and 19 been amended. Also, new claims 26 and 27 have been added. The foregoing changes do not involve any new matter. The Applicant respectfully requests reconsideration of the rejections and objections in view of the above amendments and the following remarks.

The Examiner rejected claims 1, 2, 4, 5, 9, 20 and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,014,435 to *Rosen*. (Office Action, at page 2). As applied to canceled claims 20 and 24, this ground of rejection is now moot. As applied to claims 1, 2, 4, 5 and 9, the Applicant traverses this ground of rejection for the following reasons. Independent claim 1 has been amended to clarify that the controller of the call restriction device is programmable with both call restriction data and call restriction procedures via the transceiver. In contrast, the *Rosen* patent teaches only the input of call restriction data, i.e., telephone numbers, into the call restriction device. There is no suggestion that the device can be programmed to perform different call restriction procedures.

The Examiner also states that *Rosen*:

teaches that the apparatus 4 has transceiver for transmitting and receiving tone signals to the telephone line and inherently conductors for sending digital signals to and receiving digital signal from the controller 6 inasmuch as the transceiver. (Fig 2, elements 5 and 7, and the communication between microcontroller 6 and elements 5 and 6)

(Office Action, p. 2; emphasis added.) The Applicant respectfully disagrees.

The touch tone decoder/detector (element 5) and autodialer (element 6) in Fig. 2 of *Rosen* are clearly two separate elements and not a single “transceiver” as required by claim 1. Neither is the touch tone decoder/detector and autodialer a single “converter” as required by claim 20. Further, the Applicant points out that neither the touch tone detector by itself nor the autodialer by itself performs the two different sets of send-receive/convert functions recited in claim 1 and claim 20. Specifically, unlike the transceiver of claim 1, nothing in *Rosen* teaches or discloses that the touch tone decoder/detector sends a signal to the telephone line or receives a signal from the “microcontroller” or that the autodialer sends a signal to the controller or receives a signal from the telephone line. Similarly, unlike the converter of claim 20, nothing in *Rosen* teaches or discloses that the touch tone decoder/detector converts digital signals from a digital processor into tone signals or that the autodialer converts tone signals on the telephone line into digital signals.

The Examiner’s contention appears to be based on the belief that the combination of the touch tone decoder/detector and autodialer teaches or suggests the transceiver of claim 1 and also (although the Office Action does not so state) the converter of claim 20. However, the combination of the touch tone decoder/detector and autodialer of *Rosen* cannot be used to anticipate claim 1 or claim 20 insofar as the transceiver and converter recited in said claims are concerned. This is because “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference.” MPEP 2131, *citing*, Verdegaal Bros. v. Union Oil, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Further, although identity of terminology is not required, “[t]he elements must be arranged as required by the claim....” MPEP 2131, *citing*, In re Bond, 910 F.2d 831, 15 USPQ2d 1566. (Fed Cir. 1990) (emphasis added).

Based on the foregoing, *Rosen* fails to disclose all of the limitations of amended claim 1. As such, the Applicant submits that the anticipation rejection of claim 1 should be withdrawn. Claims 2, 4, 5, 6, and 9 depend from claim 1 and are allowable for the same reasons as claim 1.

In addition, the Examiner states that as to claim 6, “it is inherent that the apparatus 4 has a circuit for supplying power only when a telephone goes off hook because as seen in Figs. 1 and 2, no external power supply or circuit is shown.” (Office Action, at p. 3.) The Applicant respectfully disagrees.

Nothing in *Rosen* teaches or suggests how the invention of *Rosen* is powered. Further, the specification of *Rosen* describes Fig. 1 as a “high level block diagram” (*Rosen*, col. 2, lines 21-22) and Fig. 2 as a “mid-level block diagram” (*Rosen*, col. 2, lines 51-52). Block diagrams are preferable disclosure if they serve in conjunction with the rest of the specification to enable persons skilled in the art to select prior art apparatus that will produce the results required to practice the claimed process and to practice the invention with only a reasonable amount of routine experimentation. In re Ghiron, 169 USPQ 723, 727 (CCPA 1971). In the absence of any teaching or disclosure in the specification of *Rosen* as to how the invention disclosed therein is powered, the blocks diagrams contained in Figs. 1 and 2, by themselves do not teach or disclose “a circuit for supplying power....” as recited in claim 6.

The Examiner rejected dependent claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Rosen*. (Office Action, at p. 4) Claim 3 has been amended to clarify the subject matter recited therein. As applied to amended claim 3, Applicant respectfully traverses this rejection. As previously discussed above, *Rosen* fails to disclose all of the limitations of amended claim 1. Consequently, *Rosen* also fails to disclose all of the limitations of claim 3, which depends from claim 1 and, therefore, does not render claim 3 obvious under 35 U.S.C. § 103(a).

Dependent claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rosen* in view of U.S. Patent No. 4,095,056 to *Ewen*. (Office Action, at p. 4) Claims 7 and 8 have been amended to clarify the subject matter recited therein. The Applicant respectfully traverses this ground of rejection as applied to amended claims 7 and 8. As previously discussed above, *Rosen* fails to disclose all of the limitations of amended claim 1 and, consequently, all of the limitations of claim 7 and 8, which depend from claim 1. As such, combining *Rosen* with *Ewen* does not render claims 7 and 8 obvious.

In addition, the Examiner states that “Ewen teaches a call restriction apparatus that guards against a user flashing his/her hook switch to trick the apparatus via a time delay circuit which reads on the claimed ‘maintaining the interference . . . until a telephone on hook condition of sufficient duration is detected.’ (Col. 7, lines 22 - 36 of Ewen).” (Office Action, at p. 5) (emphasis added) The Applicant respectfully disagrees.

Nothing in the section of *Ewen* cited by the Examiner teaches or discloses “maintaining” an interference as recited in claim 7 or even “resuming” an interference as recited in claim 8. Rather, in *Ewen* when a caller whose call has been disconnected hangs up the handset, “[s]tart relay A is de-energized and contacts A6 de-energize restrict relay R and

supervisory relay C. The release of these relays is delayed by the timing circuit consisting of the resistor R1 and capacitor C1 to insure that if the caller lifts his handset again before the exchange has released his connection, he will still be disconnected by the R relay." (*Ewen*, col. 7, lines 15-21) (emphasis added). When the caller attempts to fool the toll restrictor of *Ewen* by flashing the hook switch, a series of relays and contacts are activated. (*Ewen*, col. 7, lines 22-32) However, because the supervisory relay C has remained operated because of the time delay circuit, the restrict relay disconnects the caller. (*Ewen*, col. 7, lines 30-36). Nothing in the foregoing discloses or teaches maintaining or resuming an interference as respectively recited in claim 7 and claim 8.

The Examiner further states that:

The idea of *Ewen* is to prevent using a quick on hook condition to prevent tricking the system, and the purpose of the limitations cited in claims 7 and 8 are precisely the same as that taught by *Ewen*. Moreover, implementing such an idea would not in anyway teach away from or impair the call restriction functionality taught by *Rosen*.

(Office Action, at page 5.) The Applicant respectfully disagrees.

It would not have been obvious to combine *Rosen* and *Ewen* since these two references take mutually exclusive paths to reach different solutions to solve a similar problem, and therefore, by implication each teaches away from being combining with the other. What *Ewen* teaches is using contacts and relays to disconnect a telephone from a telephone line in order to prevent unauthorized calls (see, *Ewen*, at Abstract) and also, as discussed above, to prevent the trick of a caller using a quick hook flash by using additional contacts and relays to keep the telephone disconnected. In contrast, *Rosen* does not require disconnecting a telephone from the telephone line and does not teach or disclose the use of relays and contacts. Rather, as previously discussed above, *Rosen* teaches having a dialer sending at least one DTMF digit onto

SO what
Ewen was used a 1978
computer using tubes in 78
but idea to use chips
now - not different
hook flash
anytime
using contacts & relays
now is done using
logic
how anyone from anyone
to one and very
tech is aware of this
applied wants
to argue
that's why I highlighted
idea

the telephone line to defeat a call in progress or, alternatively, having an oscillator apply an audio tone to the telephone line to prevent any meaningful communication on the line_ (See, *Rosen* at Abstract.).

Also, since *Rosen* and *Ewen* have different methods of operation, neither reference can be modified to function in the same manner as the other. This is because under MPEP 2143.01, the proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01, *citing, In re Ratti*, 270 F.3d 810, 123 U.S.P.Q. 349 (CCPA 1959).

The Examiner rejected claims 10-19, 21-23 and claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Rosen* in view of U.S. Patent No. 5,864,613 to *Flood*. (Office Action, p. 5.) Claims 10-14, 16-17, and 19 have been amended to clarify the subject matter recited therein. The Applicant respectfully traverses this ground of rejection.

With respect to claims 10 and 11, the Examiner contends that while *Rosen* does not teach the receipt of an authorization code before programming is allowed, this limitation is disclosed in *Flood*. (Office Action, at page 6) However, as previously discussed above, *Rosen* fails to disclose all of the limitations of amended claim 1. Consequently, *Rosen* also fails to disclose all of the limitations of claims 10 and 11, which depend from amended claim 1. Thus, combining *Rosen* with *Flood* is not sufficient to render claims 10 and 11 obvious.

Also, the Applicant submits that it would not have been obvious to combine *Rosen* and *Flood* since these two references take mutually exclusive paths to reach different

solutions to solve a similar problem, and therefore, by implication each teaches away from being combining with the other. *Rosen* discloses using a DTMF or audio tone to prevent calling unauthorized telephone numbers. On the other hand, *Flood* discloses uncoupling the telephone from the telephone network using a switch. *See, Flood*, at Abstract and col. 1, lines 54-65. Since *Flood* and *Rosen* teach away from each other, it would not be logical to combine them.

Also, since *Flood* and *Rosen* have different methods of operation from each other, neither reference can be modified to function in the same manner as the other. This is because under MPEP 2143.01, the proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01, citing *In re Ratti*, 270 F.3d 810, 123 U.S.P.Q. 349 (CCPA 1959)

As to independent claims 12, 16, 19, 21 and dependent claim 22, the Examiner refers to his earlier discussions regarding *Rosen* and *Flood*. (Office Action, at p. 6.) The Applicant respectfully disagrees and reference is made to Applicant's earlier contentions above with respect to *Rosen* and *Flood*.

The Examiner further states while *Flood* does not specifically teach a remote computer or IVR:

Flood does contemplate for example in a residential embodiment, having a switch 104 (wherein the call restriction functionality is located) remotely located from the telephone 102 to which the call restriction would be applied. Flood also contemplates that the switch 104 may be co-located with the telephone 102. (Fig. 1, Col. 3, lines 1 - 10) Therefore, although Flood does not specifically teach the use of a remote computer/IVR such would certainly at the least have been

obvious to one of ordinary skill in the art at the time the invention was made.

(Office Action, at page 7.) The Applicant respectfully disagrees.

The term "remote" as used in the claims 12 and 21 refers to a computer that is remote from the call restriction device. In contrast, in *Flood* the call caging system 100 is the call restriction device and it is programmed by the user dialing an access code for the call caging device and then programming the call caging device directly. It would certainly not be obvious to have the telephone user call a remote computer instead, and then interact with the remote computer, which remote computer then downloads the required programming to the call restriction device based on the telephone user's requested call restrictions. Moreover, the Examiner has articulated no motivation for such an unobvious change. Such motivation must be found in either *Rosen* or *Flood*. In the absence of such motivation, the Examiner has failed to make a *prima facie* case for obviousness.

In addition, amended claim 12 recites that signals representing call restriction data and call restriction procedures are sent onto the telephone line from the telephone to the remote computer, and then signals representing corresponding programming code are sent onto the same telephone line from the remote computer to the call restriction device. This is nowhere disclosed or suggested in either *Rosen* or *Flood*.

The Applicant submits that the Examiner has made an improper obviousness rejection because neither reference discloses a remote computer that programs the call restriction device. Instead of find some elements of the claim in *Rosen* and the remaining elements of the claim in *Flood* and then showing it would be obvious to combine this elements, the Examiner has admitted that an element of the claim is not in either reference, but improperly asserts that it

would be obvious to add the missing element without giving any reason or logic based on the teaching of the cited references. The Applicants submit that the Examiner reference modifying voice mail is inapt, irrelevant, improper, and without support in the cited prior art. If the Examiner is taking judicial notice of some aspect of home voice mail, the Applicant traverses this judicial notice and requests that prior art be cited to support the Examiner's, as required by the rules of patent examination procedure.

Based on the foregoing, the combination of *Rosen* and *Flood* does not render claims 12, 16, 19 and 21 obvious. Claim 22 depends from claim 21 and is allowable for the same reasons as its parent claim.

As to claims 13-15, 1 (the Applicant assumes that the Examiner actually meant claim 17) and claim 18, the Examiner refers to his rejections of claims 10 and 12. (Office Action, at p. 7) The Applicant respectfully disagrees with Examiner's contentions and submits that claim 13-15 and claim 17-18 are allowable for the reasons previously discussed above with respect to claims 10 and 12. In addition, the Applicant notes that claim 13-15 depend from claim 12 and claims 17-18 depend from claim 16 and are therefore allowable for the same reasons as their respective parent claims (*see above*).

As to claim 23 and independent claim 25, the Examiner refers to his rejections of claim 1 and 3. The Applicant respectfully disagrees for the same reasons previously discussed above with respect to claims 1 and 3.

The Examiner also states that:

Further note, that if the intensity of the interfering tone/signal had to be increased then it is obvious at the least, that a claimed first signal would be, as taught above, sent to invoke the call restriction and apply the

interference signal in the first place, and of course a second signal would be sent to increase the intensity if it was determined that the intensity of the original interference signal was not sufficient. Because “increasing” the intensity of a signal is contemplated, then a two-step process such as the one described above would be needed.

Office Action, at page 7-8. The Applicant respectfully disagrees.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. MPEP 706.2(j). Nothing in *Rosen*, *Ewen* or *Flood* teaches or discloses sending more than one signal or sending a first signal and second signal or even provides any suggestion or motivation to modify *Rosen*. In fact, *Rosen* already teaches that the intensity of the tone placed on the line is “sufficiently loud as to totally disrupt any attempt at communication in the line...” (*Rosen*, col 4, lines 39-42) which precludes any need, suggestion or motivation for a first and second signal or a two-step process that the Examiner describes.

In addition, claim 23 depends from claim 21 and is allowable for the same reasons as its parent claim. Further, claim 25 recites a DTMF transceiver having a port for outputting DTMF signals in both the programming mode and the call inhibition mode. No such limitation is disclosed in *Rosen*, *Flood* or even *Ewen*. Based on the foregoing, claims 23 and 25 are allowable.